

## REMARKS

Claims 1-24 are pending in the present application. No claims have been amended herein and, therefore, claims 1-24 remain pending in this application. Applicants believe that the present application is now in condition for allowance, which prompt and favorable action is respectfully requested.

### *Claim Rejections – 35 USC § 102*

Claims 1-24 are rejected under 35 USC § 102 (e), as being anticipated by Mazzara (U.S. 2003/0087642). Applicant respectfully traverses the rejections, and reconsideration is requested. The following is a comparison between embodiments of the present invention and the cited reference.

Independent claim 1, for example, recites determining whether the selected wireless communications system from the preferred roaming list is a useable wireless communications system or an unusable wireless communications system; and repeating the step of selecting when the selected wireless communications system is determined to be an unusable wireless communications system, wherein the selected wireless communications system is determined to be an unusable wireless communications system when a system identifier for the selected wireless communications system matches a system identifier in the list of unusable wireless communications systems and when avoidance criterion corresponding to the system identifier in the list of unusable wireless communications systems is satisfied.

Mazzara, on the other hand, discloses a method of providing a wireless service connection, in which a failed connection notification may be received on a primary channel of a prioritized access list, and a secondary channel of the prioritized access list may be selected in response to the failed connection notification. (Abstract). As the Examiner suggests, Mazzara maintains a preferred roaming list in which services are prioritized based on identifiers allocated

using condition factors. Prioritized services may be separated into preferred services and non-preferred services. The disclosed method of Mazzara includes attempting to connect to the preferred services first, and, when connection to the preferred services is unsuccessful, then a non-preferred service may be loaded, along with a connection number for a call center service and an origination request for a call connection. (See, Mazzara, paragraphs [0040] and [0050]-[0056]).

Based on the cited portions of Mazzara, it appears that the Examiner has interpreted a “non-preferred service”, as discussed in Mazzara, to be equivalent to an “unusable wireless communications system”, as recited in independent claim 1. It is respectfully submitted, however, that one of ordinary skill in the art would not equate a non-preferred service to an *unusable* system. As described above with reference to Mazzara, a non-preferred service may still be used after the list of preferred services is exhausted. A non-preferred service is, in fact, *useable* even if it is prioritized lower than other services.

Therefore, Mazzara does not teach or suggest maintaining a list of unusable wireless communications systems, as recited in independent claim 1, for example. It follows that Mazzara further fails to teach or suggest determining whether the selected wireless communications system from the preferred roaming list is a useable wireless communications system or an unusable wireless communications system; and repeating the step of selecting when the selected wireless communications system is determined to be an unusable wireless communications system, wherein the selected wireless communications system is determined to be an unusable wireless communications system when a system identifier for the selected wireless communications system matches a system identifier in the list of unusable wireless communications systems and when avoidance criterion corresponding to the system identifier in the list of unusable wireless communications systems is satisfied.

A claim is anticipated under 35 USC § 102 only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001) Further, "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). (See MPEP 2131).

In this case, the Examiner has failed to cite a portion of Mazzara disclosing each and every element set forth in independent claim 1, for example. Therefore, it is respectfully submitted that the rejection thereof should be withdrawn.

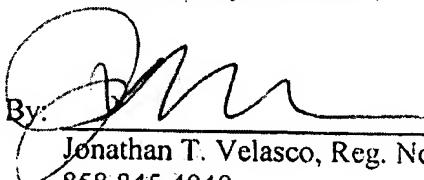
The remaining pending independent claims recite "... a list of **unusable** wireless communications systems..." (emphasis added). Therefore, the remaining pending independent claims patentably distinguish over the cited reference for at least the reasons provided herein. The pending dependent claims inherit the patentability of their respective independent claim, and the rejections thereof should be withdrawn as well.

### CONCLUSION

In light of the amendments contained herein, Applicants submit that the application is in condition for allowance, for which early action is requested.

Please charge any fees or overpayments that may be due with this response to Deposit Account No. 17-0026.

Respectfully submitted,

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